

THIS DISPOSITION  
IS NOT A PRECEDENT  
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

WINTER

Mailed: December 14, 2010

Cancellation No. 92051832

Merz Pharmaceuticals, LLC and  
Merz Incorporated

v.

Montani Cosmetics Inc.

Before Zervas, Walsh, and Bergsman,  
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of respondent's motion (filed July 22, 2010) to strike petitioner's second amended petition to cancel, petitioners' cross-motion (filed August 3, 2010) to reopen the time to file its second amended petition to cancel, respondent's motion (filed July 2, 2010) for summary judgment, and petitioners' cross-motion (filed August 6, 2010) for summary judgment. All motions are fully briefed.

For purposes of this order, the Board presumes the parties' familiarity with the pleadings and the arguments and evidence submitted with respect to the parties' respective motions.

**Motions to Strike and to Reopen Time to File Amended Pleading**

In our order mailed June 25, 2010, we granted petitioners leave to amend the allegations in paragraph 9 of the amended petition to cancel, and allowed twenty days from the mailing date of that order to file a second amended petition to cancel (order, at 7). Thus, petitioners' second amended petition was due on or before July 15, 2010.

Petitioners filed their second amended pleading on July 19, 2010.

Respondent requests that the Board strike petitioners' second amended pleading, in relevant part, on the basis that it was untimely filed. In response, petitioners filed a cross-motion to reopen the time to file their second amended pleading, arguing that the untimely filing was not prejudicial to respondent; that the delay in filing was minimal and was not willful or in bad faith; and that the delay was the result of a docketing error, thus, the error assertedly constitutes excusable neglect.

Generally, the Board will not consider untimely submissions. See *Saint-Gobain Corporation v. Minnesota Mining and Mfg. Co. a/k/a 3M*, 66 USPQ2d 1220, 1221 (TTAB 2003) (untimely reply brief received no consideration); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (applicant's response to opposers' cross motion for judgment untimely and given no

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consideration). However, Fed. R. Civ. P. 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), provides for an enlargement of time after the expiration of the specified time period "where the failure to act was the result of excusable neglect." See also TBMP § 509.01(b) (2d ed. rev. 2004). Thus, upon a showing of "excusable neglect," the Board may reopen a prescribed time for filing a late submission.

The relevant case which addresses the excusable neglect standard is *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). In *Pioneer*, the Supreme Court stated that a determination of excusable neglect is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include ... (1) the danger of prejudice to the [nonmovant], (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Pioneer*, 507 U.S. at 395. In *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997), the Board noted that several courts have held that the third *Pioneer* factor, i.e. "the reason for the delay, including whether it was

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within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. See also *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998); and *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997).

In deciding petitioners' motion to reopen, we turn to the third and most important *Pioneer* factor, namely, the reason for the delay, including whether it was within the reasonable control of petitioners. Petitioners' counsel explains that the due date for filing the amended pleading was incorrectly docketed to include the five-day enlargement period under Trademark Rule 2.119(c). Petitioners' failure to take action during the allowed period of time for filing the amended pleading was not attributable to any circumstances that were outside its reasonable control. Docketing errors and misreading of the Trademark Rules<sup>1</sup> are considered to be circumstances wholly within counsel's control. See *Baron Philippe de Rothschild*, 55 USPQ2d at 1851. In view thereof, we find that the third factor for excusable neglect weighs heavily against petitioners in this case.

As for the second *Pioneer* factor, namely, the length of the delay and its potential impact on the proceedings, we

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<sup>1</sup> Trademark Rule 2.119(c) does not apply to an action that must be taken by a party within a time set in a communication from the Board. TBMP § 113.05 (2d ed. rev. 2004) (emphasis original).

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provided petitioners with ample time to amend a single paragraph in their first amended petition to assert that respondent made an admission against interest in its July 22, 2008 letter to petitioner Merz Pharmaceuticals,<sup>2</sup> to allege bad faith on the part of respondent to support petitioners' claim of likelihood of confusion,<sup>3</sup> and to make such allegations without inappropriately alleging fraud.<sup>4</sup> Further, an additional four months have gone by pending our determination of the subject motion to reopen. In view of the foregoing, petitioners' delay in filing its second amended petition to cancel, together with the resultant filing of the subject motion to reopen, have unnecessarily delayed this proceeding. Thus, the second *Pioneer* factor also weighs against petitioners.

With respect to the remaining *Pioneer* factors, we find that the first and fourth factors favor neither petitioners

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<sup>2</sup> See petitioners' cross-motion for summary judgment, exhibit to declaration of Robert Burgess.

<sup>3</sup> See *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2003) ("bad faith is strong evidence that confusion is likely [under the thirteenth *du Pont* factor], as such an inference is drawn from the imitator's expectation of confusion").

<sup>4</sup> To be clear, we stated in our June 25, 2010 order, "it is not at all clear from the pleading whether petitioners are alleging fraud in procuring the registration, or that respondent is somehow bound by its previous representations relating to registration of the MERDERMIS mark, and that respondent's letter of July 22, 2008, constitutes an admission against interest. In any event, since petitioners have previously stated that they are not claiming fraud as a ground for cancellation, allegations of fraud in this context do not appear relevant or appropriate."

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nor respondent. Inasmuch as there has been no showing of lost evidence or unavailable witnesses, there does not appear to be any measurable prejudice to respondent should the Board allow the filing of the second amended petition to cancel. *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (citations omitted). Further, the record includes no evidence of bad faith on the part of petitioners.

Thus, even though we treat *Pioneer* factors one and four as neutral, factor two weighs against petitioners, and we accord considerable weight to the third *Pioneer* factor. In view thereof, we find that petitioners have not demonstrated excusable neglect. Accordingly, petitioners' motion to reopen the time for filing its second amended petition to cancel is denied, and petitioners' second amended petition will not be considered. Respondent's motion to strike petitioners' amended pleading is thus moot.

Consequently, petitioners' amended petition to cancel filed on February 8, 2010, which was accepted by the Board in its order mailed February 22, 2010 (order, at 5), remains petitioners' pleading of record. However, in accordance with the Board's order mailed June 25, 2010, discussed *supra* (order, at 7, stating that the motion to strike in regard to paragraph 9 appears well taken), paragraph nine of the amended petition is hereby stricken. See Fed. R. Civ. P. 12(f).

**Motions for Summary Judgment**

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993). Further, the Board may only ascertain whether issues of material fact are present, and may not resolve factual issues. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

The fact that the parties filed cross-motions for summary judgment does not mean that there are no genuine issues of material fact and that trial is unnecessary. Each party has the initial burden of demonstrating the absence of any genuine issue of material fact with respect to its own motion. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d

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1560, 4 USPQ2d 1793 (Fed. Cir. 1987); and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994).

Based on our review of the evidence and arguments submitted by the parties, we find that respondent, as the party moving for summary judgment, has not met its burden of establishing that no genuine issues of material fact exist as to petitioners' claim that there is a likelihood of confusion between the parties' respective marks and that it is entitled to judgment as a matter of law. At a minimum, there exist genuine issues of material fact as to the similarity of the MEDERMIS (and design) and MEDERMA and MEDERMA formative marks, and as to the strength of petitioners' MEDERMA and MEDERMA formative marks. See *Olde Tyme Foods v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (comparing "Old Time" with "Ye Olde Tyme", determined that "phonetic similarity alone is insufficient in this case to establish as a matter of law that the uses of the respective marks are likely to cause confusion"); and *Fishking Processors, Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1766 (TTAB 2007) (finding that genuine issues exist as to the similarities of petitioner's trade names and mark vis-à-vis respondent's mark, especially with respect to connotations and commercial

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impressions). For the same reasons,<sup>5</sup> we find that petitioners have not established the absence of genuine issues of fact with respect to their claim of likelihood of confusion.<sup>6</sup>

Accordingly, respondent's motion for summary judgment and petitioners' cross-motion for summary judgment are denied.<sup>7</sup>

Further, because this is the second time that we have

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<sup>5</sup> Although we have mentioned only two genuine issues of material fact in this decision, that is not to say that these are the only issues of material fact in dispute.

In that regard, we note that petitioners submitted as attachments to their counsel's declaration only copies of the certificates of registration of their pleaded registrations. Petitioners are reminded that for purposes of summary judgment or at trial, to establish ownership of a pleaded trademark registration, a plaintiff must submit evidence establishing both the current status of and current title to the registration. See Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d); and TBMP § 528.05(a) (2d ed. rev. 2004). See also *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009) (for proceedings filed after August 1, 2007, a party may submit either a copy of the registration prepared and issued by the USPTO *showing the current status and title of the registration* or a current printout from the electronic database records of the USPTO *showing the current status and title of the registration*) (emphasis added); and *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (mere fact that copies show that registrations were originally issued to opposer does not establish that pleaded registrations are still extant or that title presently resides in opposer).

<sup>6</sup> Although petitioners did not seek summary judgment on the pleaded ground of dilution, petitioners are reminded that for dilution purposes, at trial, petitioners must prove more than similarity of the marks; they must show that the marks are "very or substantially similar." See *The Toro Company v. Torohead, Inc.*, 61 USPQ2d 1164, 1183 (TTAB 2001).

<sup>7</sup> The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See, e.g., *Levi*

been asked to consider granting summary judgment in this proceeding, and the second time that we have found that there are genuine issues of material fact, **the parties may not file any further motions for summary judgment. If the parties believe that this proceeding may be resolved without resort to a formal trial, the parties may stipulate to resolve this proceeding by means of the Board's Accelerated Case Resolution (ACR) procedure. See, e.g., Eveready Battery Company, Inc. v. Green Planet, Inc., 91 USPQ2d 1511 (TTAB 2009).** With respect to ACR, the parties are referred to the following web pages: <http://www.uspto.gov/trademarks/process/appeal/acrognoticerule.pdf> and <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

**Proceeding Resumed; Trial Dates Reset**

This proceeding is resumed. Trial dates are reset as follows:

Initial Disclosures Due	1/8/2011
Expert Disclosures Due	7/22/2011
Discovery Closes	8/21/2011
Plaintiff's Pretrial Disclosures	10/5/2011
Plaintiff's 30-day Trial Period Ends	11/19/2011
Defendant's Pretrial Disclosures	12/4/2011
Defendant's 30-day Trial Period Ends	1/18/2012
Plaintiff's Rebuttal Disclosures	2/2/2012
Plaintiff's 15-day Rebuttal Period Ends	3/3/2012

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*Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). See TBMP § 528.05(a) (2d ed. rev. 2004).

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**IN EACH INSTANCE**, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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